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| EXAMINER |
|---|
| MEJIA, ANTHONY |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2151 | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

| | Application No. | Applicant(s) |
|---|---|---|
| | 10/729,468 | CHEFALAS ET AL. |
| **Office Action Summary** | Examiner | Art Unit | |
| | ANTHONY MEJIA | 2151 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on <u>14 April 2008</u>.

2a) ☒ This action is **FINAL.**     2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) <u>1 and 15</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1 and 15</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All    b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1.      The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2.      Claims 1 and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 recites the limitations: "…including installing the newest versions of computer programs, *utilities, and vendor interfaces from the Internet* or from said server dedicated to storing user computer's images and their updates" in page 4, lines 3-4. The claimed subject matter is not described in the applicant's specification.

3.      The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4.      Claims 1 and 15 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear and/or ambiguous, in that it raises uncertainty on as to *how* the first means further monitors and records incremental

changes and modifications to said user configuration *over the life time of said user*

*configuration*. For the further purposes of further examination, the examiner will interpret

that the first means further monitors and records incremental changes and modifications

to said user configuration *for the life time of said user configuration*, by monitoring and

recording the settings used in previous installations (*see* page 4, lines 21-22).


### Claim Rejections - 35 USC § 101

5.      35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or
> composition of matter, or any new and useful improvement thereof, may obtain a patent therefor,
> subject to the conditions and requirements of this title.

6.      Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is

directed towards non-statutory matter. For example, in claim 1 of the instant case, a

"first means", "means for accessing…", and "second means" are all directed towards a

software agent, which is basically software (*see* page 4, lines 5-18, and page 6, lines

16-17, lines 20-22). Computer-related inventions whether descriptive or functionally

descriptive material are non-statutory categories when claimed as descriptive material

*per se* (see *Warmerdam, 33 F.3d at 1360 USPQ2d at 1759)*, falling under the "process"

category (i.e. inventions at that consist of a series of steps or acts to be performed). See

35 U.S.C. 100(b) ("The term process means, art, or method, and includes a new of a

known process, machine, manufacture, composition of matter or material").  Functional

descriptive material: "data structures" representing descriptive material *per se* or

computer program representing computer listing *per se* (i.e. software per se) when

embodied in a computer-readable media are still not statutory because they are not

capable of causing functional change in the computer. However, a claimed computer-

readable *storage* medium encoded with a data structure, computer listing or computer

program, having defined structural and functional interrelationships between the data

structure, computer listing or computer program and the computer software and

hardware component, which permit the data structure's, listing or program's functionality

to be realized, is statutory (see MPEP §2106).

In further, Claim 15 is also rejected under 35 U.S.C. 101 because the claimed

"computer program product" is directed towards non-statutory subject matter. Although

this claim is nominally directed towards a "computer-program product", the limitations

listed in claim 1 as discussed above, are all descriptive material *per se*. (see

*Warmerdam, 33 F.3d at 1360 USPQ2d at 1759),* falling under the "process" category

(i.e. inventions at that consist of a series of steps or acts to be performed). See 35

U.S.C. 100(b) ("The term process means, art, or method, and includes a new of a

known process, machine, manufacture, composition of matter or material"). Functional

descriptive material: "data structures" representing descriptive material *per se* or

computer program representing computer listing *per se* (i.e. software per se) when

embodied in a computer-readable media are still not statutory because they are not

capable of causing functional change in the computer. However, a claimed computer-

readable *storage* medium encoded with a data structure, computer listing or computer

program, having defined structural and functional interrelationships between the data

structure, computer listing or computer program and the computer software and

hardware component, which permit the data structure's, listing or program's functionality

to be realized, is statutory (see MPEP §2106). Therefore, the claimed computer

program product contains embodiments that are non-statutory, in which they may be

directed towards software only, and software *per se* is non-statutory subject matter.


### Claim Rejections - 35 USC § 103

7.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

8.      Claims 1 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Woodard et al. (US 7,032,011) (referred herein after as Woodard) in view of Boxall et al.

(US 2003/0046678) (referred herein after as Boxall) and in further view of Tomoson et

al. (US 6,931,523) (referred herein after as Tomoson).

Regarding Claim 1, Woodard discloses a system for automatically configuring

reinstall information to a computer (second computer-based device), said system

comprising:

a server (server 200) for storing (user database 206) user computers' images

(settings/profiles) and their updates (col.5, lines 1-9, and 38-56) and at least one user

computer (first computer-based device) having a user configuration of a user operating

system and at least one application program (col.5, lines 34-35),

first means (software module (SEIM)) for storing on said server the parameters of

said user configuration (col.4, lines 30-36 and col.6, lines 7-29);

a set of backup non-specific copies, stored on said server dedicated to storing user computers' images and their updates of a set of operating systems, including said user operating system, and a set of application programs, including said at least one application program (col.5, lines 40-44, col.6, lines 46-49, and col.21, lines 46-55);

means (software module (SEIM)) for accessing said back up non-specific copies of operating systems, including said user operating system, and a set of application programs, including said at least one application program (col.5, lines 40-44, col.7, lines 59-66); and

second means (software module (SEIM)) for restoring said user configuration by copying said operating system, and a set of application programs, including said at least one application program from said set of backup non-specific copies to said user computer in accordance with the parameters of said user configuration (col.8, lines 17-44, and col.21, lines 46-55). Woodard does not explicitly teach the step wherein, said first means for storing said user configuration parameters further monitors and records user choices during an installation process of installing said user configuration.

However, Boxall in a similar field of endeavor discloses a method of installing hardware and corresponding software further comprising the step of:

wherein, a first means (installation script 64) for storing said user configuration parameters further monitors and records user choices during an installation process of installing said user configuration (par [0022], [0025], [0030] and *see* fig.2)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings Boxall in Woodard in order to minimize the

waiting time of the installation process by being able to implement previously chosen choices of a previously installed configuration. One of ordinary skill in the art at the time the invention was made would have been motivated to combine the teachings of Woodard and Boxall to optimize the use of the system by minimizing waiting time and requirements for user intervention during the installation of a previously installed configuration.

In further, the combined teachings of Woodard and Boxall do not explicitly teach the step wherein said first means further monitors and records incremental changes and modifications to said user configuration over the life time of said user configuration.

However, Tomoson in a similar field of endeavor discloses a system and method of providing a known-good configuration for a computer, comprising storing a known-good computer configuration and restoring a known-good configuration via non-interactive user input including the step wherein a first means (software) further monitors and records incremental changes and modifications to said user configuration over the life time of said user configuration (col.5, lines 46-54).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Tomoson in the Woodard/Boxall system in order to store a record of the change configuration information since the last full configuration of a computer. One of ordinary skill in the art at the time the invention was made would have been motivated to combine the teachings of Woodard/Boxall/Tomoson to further conserve the storage space of the system.

The combined teachings of Woodard/Boxall/Tomoson further teach wherein said first means further migrates a current computer to a new computer (Woodard: second computer-based device, col.8, lines 17-44), based on said recorded user choices (Boxall: par [0022], [0025], [0030] and *see* fig.2) and said incremental changes and modifications information collected and saved (Tomoson: col.5, lines 46-54), and

said migrating, including installing the newest versions of computer programs, utilities and vendor interfaces from the Internet or from said server dedicated to storing user computers' images and their updates (col.5, lines 45-47, and col.7, lines 1-4).

Regarding Claim 15, The combined teachings of Woodard/Boxall/Tomoson teaches an article of manufacture comprising a computer usable medium having computer readable program code means embodied therein in computer readable form (Boxall: par [0015-0016], and par [0022]) comprising:

means (software module (SEIM)) for performing a method for operating a system for automatically configuring reinstall information comprising a server (server 200) for storing (user database 206) user computers' (first computer-based device) images (settings/profiles), and their updates (col.5, lines 1-9, and 38-56), and

at least one user computer (first computer-based device) having a user configuration of a user operating system and at least one application program (col.5, lines 1-9, 38-56 and col.6, lines 51-64),

said method comprising the steps of:

storing (user database 206) on said server (server 200) the parameters of said user configuration (col.5, lines 1-9, and 38-56);

storing a set of backup non-specific copies, stored on said server dedicated to storing user computers' images and their update, of a set of operating systems, including said user operating system, and a set of application programs, including said at least one application program (col.5, lines 40-44, col.6, lines 46-49, and col.21, lines 46-55);

accessing said copies, and restoring said user configuration by copying said operating system, and a set of application programs, including said at least one application program from said server dedicated to storing user computers' images and their updates to said user computer in accordance with the parameters of said user configuration (col.5, lines 40-44, col.7, lines 59-66, and col.21, lines 46-55),

wherein, said method further comprises means for monitoring and recording user choices during an installation process installing said user configuration (Boxall: par [0022], [0025], [0030] and *see* fig.2), and

further monitoring and recording incremental changes and modifications to said user configuration over the life time of said user configuration (Tomoson: col.5, lines 46-54); and

further, migrating a current computer to a new computer (Woodard: second computer-based device, col.8, lines 17-44), based on said recorded user choices (Boxall: par [0022], [0025], [0030] and *see* fig.2) and said incremental changes and modifications information collected and saved (Tomoson: col.5, lines 46-54),

said migrating, including installing the newest versions of computer programs,

utilities and vendor interfaces from the Internet or from the said server dedicated to

storing user computers' images and their updates (col.5, lines 45-47, and col.7, lines 1-

4).

### Response to Amendments

7.      Amendment to the specification in response to examiner's objection has been

considered. The amendment obviates previously raised objection, as such this

specification hereby withdrawn.

        Amendment to Claims 1 and 15 in response to examiner's objection has been

considered. The amendment obviates previously raised objection, as such this objection

hereby withdrawn.


### Response to Arguments

8.      Applicant's arguments filed 14 April 2008 have been fully considered but are

deemed moot in view of the following new grounds of rejection as explained here below,

necessitated by Applicant's substantial amendments (i.e., amendment of claims 1 and

15: "*wherein, said first means for storing said user configuration parameters further*

*monitors and records user choices during an installation process of installing said user*

*configuration, and further monitors and records incremental changes and modifications*

*to said user configuration over the life time of said user configuration; and further*

*migrates a current computer to a new computer, based on said recorded user choices*

*and said incremental changes and modifications information collected and saved, said*

*migrating, including installing the newest versions of computer programs, utilities and*

*vendor interfaces from the Internet or from said server dedicated to storing user*

*computers' images and their updates."*) to the claims which significantly affected the

scope thereof.


A)      As to Claims 1 and 15, Applicant alleges that Claims 1 and 15 as amended is not

unpatentable over Sedlack in view of Collins and in further view of Bergman because

the combination of Sedlack/Collins/Bergman do not explicitly disclose the functionalities:

means for storing said user configuration parameters, monitoring and recording user

choices during an installation process, installing said user configuration over the life

time of said user configuration; wherein information collected and saved is used to

migrate the current computer system to a new computer, whereas while migrating,

depending on the user indication or relevant information provision the newest versions

of computer programs, utilities and vendor interfaces may be installed from the

computers' images and their updates.  In further, Applicant argues that although

Bergman discloses a process of execution trace, which monitors user choices during an

installation process, Bergman does not explicitly disclose the functionality that further

monitors and records incremental changes and modification *over the lifetime of said*

*user configuration.*

        As to point A) above, Applicant's arguments with respect to Claims 1 and 15

have been considered but are moot in view of the new ground(s) of rejection.

B)      Also, as to Claims 1 and 15, Applicant further alleges that Claims 1 and 15 as

amended is not is not unpatentable over Sedlack in view of Collins and Bergman, and

yet in further view of Richard because the combination of

Sedlack/Collins/Bergman/Richard do not explicitly disclose the functionality for

monitoring and recording incremental changes and modifications to said user

configuration; wherein information collected and saved is used to migrate the current

computer system to a new computer, whereas while migrating depending on the user

indication or relevant information provision the newest versions of computer programs,

utilities, and vendor interfaces may be installed from the Internet or from said server

dedicated to storing user computers' images and their updates. In further, Applicant

argues that although the combination of Sedlack/Collins/Bergman/Richard disclose

steps for performing an incremental backup process, these steps are performed in the

context of making a generic incremental backup procedure that is based on monitoring

modifications of the archive bit of the target files and not incremental changes to system

images, to be backed up.

       As to point B) above, the Applicant's arguments with respect to Claims 1 and 15

above, have been considered but are moot in view of the new ground(s) of rejection.


### *Conclusion*

9.      Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action.  Accordingly, **THIS ACTION IS MADE FINAL**.  See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.


10.      Reply to a final rejection or action must include cancellation of, or appeal from

the rejection of, each rejected claim. If any claim stands allowed, the reply to a final

rejection or action must comply with any requirements or objections as to form (see

1.113). If prosecution in an application is closed, an applicant may request continued

examination of the application by filing a submission and the fee set forth in § 1.17(e)

prior to the earliest of: (c) A submission as used in this section includes, but is not

limited to, an information disclosure statement, an amendment to the written description,

claims, or drawings, *new arguments, or new evidence in support of patentability*. If reply

to an Office action under 35 USC 132 is outstanding, the submission must meet the

reply requirements of § 1.111 (see MPEP 706.07)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANTHONY MEJIA whose telephone number is (571)270-3630. The examiner can normally be reached on Mon-Thur 9:30AM-8:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Anthony Mejia
Patent Examiner

/Salad  Abdullahi/

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